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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,030	04/27/2001	Atsushi Tanaka	43890-511	7217

20277 7590 08/15/2005

MCDERMOTT WILL & EMERY LLP
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WASHINGTON, DC 20005-3096

EXAMINER

LEMMA, SAMSON B

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 08/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action
Before the Filing of an Appeal Brief

Application No.

09/843,030

Applicant(s)

TANAKA ET AL.

Examiner

Samson B. Lemma

Art Unit

2132

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 July 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-4, 6-14 and 16-20.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

THOMAS R. PEESO
PRIMARY EXAMINER

✓

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's remark/arguments filed on July 29, 2005 have been fully considered but they are not persuasive. This office action is in reply to an amendment filed on July 29, 2005. Claims 5 and 15 are cancelled. Claims 1-4 and 6-14 and 16-20 are pending in the application.

Applicants amended the independent claims 1 and 11, by adding the cancelled dependent claims 5 and 15 into the respective claims 1 and 11.

The former dependent claims 5 and 15 which are added into the independent claims 1 and 11 respectively, recites the following limitation,

The data stored in said first storage means is deleted in any of events that said first wireless communication means is unable to start transmission of the data stored in said first storage means to said pre-assigned device, and that the transmission is interrupted. Examiner argues that this particular limitation is disclosed by references on the record and in particular with Isikoff. Isikoff discloses the following "This step of the security protocol may be augmented by also carrying out the destruction of this data on the laptop, for example by file deletion or overwriting data on the hard disk." [column 8, lines 42-45] and Isikoff further discloses that "when theft of the computer occurs, however, the beacon is activated with a security control program to secure crucial data in the computer's storage, to enable or disable functions of the computer, and to either transmit or destroy or hide sensitive data. The beacon's transmission signal is preferably also trackable to locate and recover the stolen computer" and this meets the limitation of the data stored in said first storage means is deleted in any of events that said first wireless communication means is unable to start transmission of the data stored in said first storage means to said pre-assigned device, and that the transmission is interrupted.

The other Applicant's argument is regarding to the previous office action made by the examiner and related to the independent claims 1 and 11

Applicants argued and recited the following

"Applicants respectfully submit that this analysis overlooks the fact that the GPS receiver disclosed at the cited portion of Isikoff is directed to a paging network/system 200 (see, Fig. 6), and is not related to the alleged portable information-processing device or the laptop 100 (see, Fig. 4). Accordingly, the Examiner's interpretation that the GPS receiver can be included in the laptop 100 departs from the disclosure of Isikoff and nothing in Isikoff suggests otherwise."

In response to the applicant's argument the Examiner would point out that Isikoff, discloses that the following. "To aid in the tracking process, GPS receiver may be included in some embodiments and the transmitter may transmit its position coordinates ".[Column 10, lines 26-29]

What the examiner implied is that the fact that the laptop has the transmitter to transmit its position coordinates to a GPS receiver is indeed disclosed in Isikoff as stated above and that meets the recitation of the limitation "wherein said portable information-processing device is capable of geographically identifying its own location". If the laptop had not had the capability to identify its geographic location using the transmitter, it would not have been able to transmit its position coordinates.

The examiner asserts that the argument made previously by the applicant which is recited as follows, "information-processing device utilizes a GPS module 206 for measuring and determining its own location. Specifically, in the status monitoring mode, the portable information-processing device activates the sensor 205 and the GPS module 206, where the CPU 201 monitors the outputs of the sensor 205 and the GPS module 206. As a result, the present invention advantageously determines whether the device is stolen based on the result of the outputs of the sensor 205" is not incorporated in the independent claim.

The applicant did not incorporate this detail as it is argued in the previous office action in to the independent claims. The disclosure by the invention over the prior art cannot be read into the claims unless and otherwise that particular feature is written in to the independent claim.

In fact, though the above detailed features with other specific limitation like claim 4 if added into the independent claims could overcome the rejection, the specification is not the measure of the invention. Therefore, limitations contained therein/assumed to be contained therein cannot be read into the claims for the purpose of avoiding the prior art. (See *In re Sporck*, 55 CCPA 743, 386 F.2d 924, 155 USPQ 687 (1968))

The other argument is related the previous argument and the above replay by the examiner sufficiently addresses the issue since what is cited meet the recitation of the limitation.

Claim 11 was rejected under 35 U.S.C. 102 (b) as being anticipated by Jeremy M. Isikoff (hereinafter referred as Isikoff) (U.S. Patent No 5,748,084) and claim 1 was rejected under 35 U.S.C. 103 (a) as being unpatentable over Jeremy M. Isikoff (hereinafter referred as Isikoff) (U.S. Patent No 5,748,084) in view of Wong et al (herein after referred as Wong) (U.S. Patent No. 6,356,196) and the rejection remains to be the same.

Therefore all the elements of the claims limitation is explicitly or implicitly or inherently suggested and disclosed by the single or the combination of the references on the record and the final rejection remains valid unless and otherwise the applicant added a specific limitation in to the present independent claim 1 and 11, to overcome the rejection with out introducing a new matter.